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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/846,658	05/01/1997	JOHN ROBERT ADAIR	CARP-0057	9631

34132 7590 08/21/2003

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EXAMINER

DAVIS, MINH TAM B

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 08/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/846,658	ADAIR ET AL.
	Examiner MINH-TAM DAVIS	Art Unit 1642

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 March 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 24-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 24-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This Office action supplements the Office action of paper No:48, of 03/28/03 in response to the crossed-mailed Supplemental Amendment of 03/18/03.

Accordingly, claims 24-31 are being examined.

REJECTION UNDER 35 USC 102(e)

Rejection under 35 USC 102(e) of claims 24-31 pertaining to anticipation by Queen et al remains for reasons already of record in paper No:43.

Applicant asserts that the Examiner position is that a single sentence in the earliest filed application by Queen et al (Application SN=07/290975, paragraph bridging pages 9-10) supports the Examiner interpretation that any reference to CDR in the claims of the Queen patent means the Kabat "plus" Chothia CDRs.

Applicant asserts that this interpretation is inconsistent with Chothia and Lesk, the remainder of the '975 specification, the prosecution history, and finally the claims themselves for the following reasons:

1) Chothia and Lesk carefully distinguishes its "hypervariabel loops" from Kabat's CDRs. Their limits are somewhat different from those of the complementary-determining regions defined by Kabat et al.

2) The remainder of the specification of the '975 specification indicates that the references to CDRs are as defined in Kabat. For example the framework regions are

defined in terms of Kabat, and thus if the framework regions are defined in terms of Kabat, the CDRs must be as well.

3) Queen never so argues in the prosecution of the Application SN=07/634278, when arguing against the obviousness rejection over Riechmann et al. There is no mentioning of a combined definition. But rather, Queen submitted a Glossary, which states that two related but distinct definitions of the CDRs are in use, i.e. the original definition of Kabat (based on sequence variability) and the newer definition of Chothia (based on 3-D structure).

3) If CDR means Kabat "plus" Chothia, the recitation in the claims "outside the Kabat and Chothia" preceding CDRs of the Queen patent is superfluous. If CDR means Kabat "plus" Chothia as advanced by the Examiner, there would be no need to recite "outside the Kabat and Chothia" after the first reference to CDR because any framework changes to donor would be, by definition, outside the Kabat and Chothia CDRs.

Applicant concludes that there is no written description support in the two earliest filed applications for the requirement that the change to donor be outside the Kabat and Chothia CDRs as recited in the claims as issued in the Queen patent. Applicant refers, for further support, to the patentees' own admission regarding the same as set forth in Applicant's response filed May 02/02 and December 23/02.

Applicant's arguments in the Supplemental response of 03/18/03 have been considered but are found not to be persuasive for the following reasons:

It is noted that it seems that Applicant misquotes the Examiner position. The Examiner did not state that CDRs means Kabat "plus" Chothia. Rather, the Examiner

position is that CDRs, as incorporated by reference by Queen et al in the '975 specification, could mean either the CDR amino acids defined by Kabat, or the amino acids in the hypervariable region taught by Chothia et al (The hypervariable regions are also called CDR's according to Queen et al, in 07/290975 application, p. 8, last paragraph, bridging p.9).

The Examiner agrees that Chothia and Lesk carefully distinguishes its "hypervariabel loops" from Kabat's CDRs. This difference between Kabat CDRs and Chothia "hypervariabel loops" does not however refute the fact that Queen et al in the specification of the parent case No: 07/290975 incorporate by reference CDRs defined as the hypervariable regions taught by Chothia et al and the CDRs as defined Kabat et al.

Further, since Queen et al incorporate by reference CDRs defined as the hypervariable regions taught by Chothia et al and the CDRs as defined Kabat et al, it is not germane that the rest of the specification of '975 application discloses as examples Kabat's CDRs.

Moreover, the claims in the two earliest patents of Queen et al are interpreted in light of the incorporation by reference in the '975 specification. How Queen et al argue in the prosecution of the '278 application is not germane to the interpretation of the '975 specification and consequently the outstanding 102(e) rejection. Similarly, whether or not the recitation in the claims "outside the Kabat and Chothia" preceding CDRs, e.g. in claim 1 of the Queen patent, is superfluous, this is not germane to the interpretation of the '975 specification and consequently the outstanding 102(e) rejection.

Further the Examiner's Answers to Applicant's responses filed May 02/02 and December 23/02 remain as set forth in previous Office actions.

In view of the above and the reasons set forth in previous Office action, the cited Queen patent is entitled to the date of the earliest application '975 and the claimed invention is anticipated by Queen et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

MINH TAM DAVIS

July 3, 2003

Susan J.
SUSAN UNGAR, PH.D
PRIMARY EXAMINER